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| 10/030,099      | 01/16/2002  | Keizaburo Matsumoto  | 020043              | 5715             |

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EXAMINER

DICUS, TAMRA

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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1774

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/030,099

Applicant(s)

MATSUMOTO, KEIZABURO

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The claim objection and rejections are withdrawn due to the amendment. The RCE is acknowledged.

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 7, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 7 refer to a “print film”, however this term is unclear. It is not clear if the print film is ink or a layer that receives printed ink or printed ink. If this film is ink, it is not clear if the ink is a continuous or discontinuous layer/film. For example, claim 7 shows this confusion by referring to “the ink layer of oil-based ink” and “the print film of the oil- based ink”.
3. Claims 7 and 8 recites the limitation “the ink layer”. There is insufficient antecedent basis for this limitation in the claim.
4. Claims 7, 8, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 7-8 and 11 recites the limitation “the layer adjoining the print film”. There is insufficient antecedent basis for this limitation in the claim. If no reasonably definite meaning can be ascribed to certain claim language, the claim is indefinite, not obvious. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970).

### ***Double Patenting***

5. Claims 1, 6, and 9 of this application conflict with claim 8 of Application No. 09/734767. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 6, and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of copending Application No. 09/734767. Although the conflicting claims are not identical, they are not patentably distinct from each other because "print" and "printed matter" have the same meaning. The instant application claims a "receiving layer" while application '767 claims a "coating layer". The

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coating layer of '767 is coated on the print sheet and contains ink jet recorded ink, the same as the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 6, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,829,700 to Phillips.

9. Phillips teaches a greeting card (printed matter) comprising a paper sheet 12 of an ink jet printed with a color ink jet printer (col. 1, line 45-46) (variable information is formed). See col. 2, line 29. The greeting card can be preprinted lithographically with any desired theme (col. 3, lines 15-20) (print film containing fixed information printed). Further, that a print film is printed by various printing methods (lithographic, intaglio, relief of instant claim 1 and ink jet printing of instant claim 9) is a process limitation in a product claim and afforded little patentable weight.

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Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698. Thus, Applicant’s article and the prior art article is the same.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,829,700 to Phillips in view of USPN 6,214,449 to Otani et al.

12. Phillips essentially teaches the claimed invention above. Phillips does not teach two receiving layers comprising an ink-absorbing and ink-fixing resin as per instant claims 2-5. Otani teaches two ink receiving layers (col. 3, lines 25-28) containing cellulose, polyvinyl alcohol (col. 4, lines 14-25) (ink-absorbing additive) and cationic dye fixing agents (col. 4, lines 27-31). Further additives include fillers of UV absorbents, pigments, and fluorescent dyes (col. 4, lines 33-37). It would have been obvious to one of ordinary skill in the art to modify the greeting card of Phillips to further include two receiving layers comprising cellulose, fillers, and ink-fixing agents because Otani teaches the inclusion of two layers provides differing density

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and ink absorbency, high image density, high surface strength and reduction in cost can be attained (col. 3, lines 24-29). The inclusion of aforesaid ink-absorbing, ink-fixing, and fillers are conventionally added to effect the image density (col. 4, lines 15-68 of Otani).

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,829,700 to Phillips in view of USPN 6,214,449 to Otani et al., and further in view of USPN 6,708,612 to Schmid.

Phillips and Otani, relied upon above, do not teach the use of an in-line system or anilox rollers as per instant claims 10 and 12. Schmid teaches a printing machine for printing sheets using an in-line operation, ink jet printers, and anilox rollers (col. 2, lines 35-40, 60-65, and col. 4, lines 23-25). Schmid discovered this machine allows two inks to be printed from two different printing machines at the same time (col. 4, lines 50-55). It would have been obvious to one of ordinary skill in the art to modify the combination of Phillips and Otani because Schmid teaches the use of ink jet printers and anilox rollers in an in-line system for the purpose of printing paper successively with different colors (col. 3, lines 55-56 and col. 4, lines 51-55 of Schmid).

### ***Response to Arguments***

13. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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15. USPN 6,272,991 to Rich et al. teaches a game card made by ink jet and lithography.
16. USPN 5,449,200 to Andric et al. teaches a security paper having a printed film.
17. USPN 4,903,599 to Kubler teaches a printed matter made by lithographic printing forms an ink film.
18. USPN 5,129,321 to Fadner teaches a lithographic printing and ink jet printing applied to paper using oil based ink and water based ink.
19. USPN 6,389,970 to Tashiro et al. teaches a direct drawing lithographic printing plate employing oil based ink and containing image-receiving layer and paper.
20. USPN 6,773,771 to Ashida teaches two ink receiving layers.
21. USPN 5,367,026 to Okude et al. teaches a composition of alkyelne and alkyl groups.
22. JP 10-080995 to Ishii et al. teaches an ink jet lithographic plate having oily ink sprayed.
23. JP 10-203039 to Ishii et al. teaches an ink jet printing plate containing paper, water-resistant layer and image receiving layer.

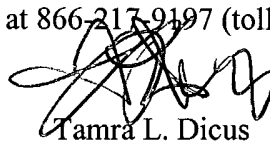
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus  
Examiner  
Art Unit 1774

September 2, 2004



**B. HAMILTON HESS  
PRIMARY EXAMINER**